

REMARKS

Claims 1, 2, 4-14, and 16-21 are pending with claims 20 and 21 being withdrawn.

Applicants acknowledge the Examiner's time and courtesy during the August 27, 2003 personal interview as well as the teleconferences of August 27 and August 28, 2003, with applicants' representative, James E. Ruland. Below is a summary of those interviews.

1. No exhibit was shown or demonstration conducted.
2. The prior art discussed was U.S. Patent No. 6,143,037 (Goldstein) and U.S. Patent No. 6,143,352 (Clark). Also, U.S. Patent No. 4,634,649 (Knapp) was discussed.
3. Claims 1, 12 and 18 were discussed.
4. No amendments are being made.

Arguments

Claims 1-2, 4-5, 8-10, and 12-14 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Goldstein and claims 6-7, 11 and 16-19 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Goldstein in view of Clark. Applicants respectfully traverse these rejections.

Goldstein discloses over 20 broad categories of medical devices, which may be coated by various compositions and methods (column 31, lines 25-48). Goldstein also discloses a host of broad categories of polymers useful in the invention (column 14, line 64 – column 15, line 10).

The fact that a claimed product might be found within the broad field of the prior art and one might arrive at it by selecting specific items and conditions does not render the product obvious in the absence of some direction or reasons for making the selection. *See Ex*

parte Koon, 132 U.S.P.Q. 359 (Pat. Bd. of App. 1962) and *In re Baird*, 29 U.S.P.Q.2d 1550 (CAFC 1994). In this case, Goldstein even prefers medical devices other than stents, such as sutures (column 31, lines 49-63), and exemplifies coating sutures, screws, and ceramic particles. See, columns 32-35. Goldstein fails to provide any preferences or examples of a stent comprising a coating or a coating for a stent where the coating comprises a polymer or a polymer mixture, which in turn, respectively comprises a polycyanoacrylic acid ester or a polymethylene malonic acid ester, or a mixture thereof, or is made from a cyanoacrylate and/or a methylene malonic acid ester. Consequently, out of the vast numbers of polymers that may be chosen to coat a variety of medical devices, Goldstein fails to provide any guideposts or blazemarks for one of skill in the art to pick out a specific combination to render applicants' invention obvious. Consequently, applicants respectfully submit that these rejections should be withdrawn.

In support of its rejection, the Action cites *In re Dillon*, 16 U.S.P.Q.2d 897 (Fed Cir. 1990), and alleges that the CAFC established that if the claimed invention and the structurally similar prior art share any useful property, that will generally be sufficient to motivate an artist in the ordinary skill to make the claimed species. However, applicants respectfully submit that the holding in *In re Dillon* is not applicable to the present case. Particularly, *In re Dillon*, was an appeal of a claim defining a hydrocarbon fuel containing tetraorthoesters. The prior art disclosed a hydrocarbon fuel comprising a triorthoester, and other prior art references establishing the equivalence between a triorthoester and a tetraorthoester. Applicants respectfully submit that motivation to substitute a tetraorthoester for a triorthoester in a prior art reference is not germane to the present case, as agreed by the examiner. See Interview Summary.

Rather, the case *In re Baird*, as mentioned above, is more applicable. In that case, a prior art reference U.S. Patent No. 4,634,649 (Knapp) disclosing a generic formula was insufficient to render a claim defining a flash fusible toner comprising a bisphenol A polyester obvious. Particularly, the Court ruled that the generic formula in Knapp contained a large number of variables, only one of which was bisphenol A. Moreover, Knapp failed to disclose any preferences or examples for selecting bisphenol A. Consequently, this formula encompassing a vast number of possible compounds was insufficient to render obvious a bisphenol A polyester containing an aliphatic di[carboxylic] acid selected from the group consisting of succinic acid, glutaric acid and adipic acid.

This is similar to the present case, where Goldstein discloses at least 10 broad classes of polymers and over 20 broad kinds of devices to be coated, creating a large class of various combinations. There are no preferences or examples for providing, e.g., a stent including a coating which includes a polycyanoacrylic acid ester, a polymethylene malonic acid ester, or a mixture thereof. Consequently, similar to *In re Baird*, there is insufficient motivation to render the present invention *prima facie* obvious.

Supererogatorily, the claimed polycyanoacrylic acid ester and polymethylene malonic acid ester have properties not mentioned by Goldstein and the other prior art, namely, that the claimed devices have an antiproliferative effect with respect to tumor cells and smooth muscle cells, the latter being advantageous to treat arteriosclerosis. See the specification at page 4 and the proof in Example 4. Thus, the claimed invention is extremely well suited for, e.g., restenosis prophylaxis. See present specification at page 4.

In view of the above, favorable reconsideration is courteously requested. If there are any remaining issues which can be expedited by a telephone conference, the examiner is courteously invited to telephone counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

James E. Ruland, Reg. No. 37,432
Attorney for Applicants

MILLEN, WHITE, ZELANO &
BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

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